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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,324	06/18/2001	Gregory F. Payne	8399-007-999	5267

7590 12/13/2002
Pennie & Edmonds
1667 K Street NW
Washington, DC 20006

EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 12/13/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,324

Applicant(s)

PAYNE ET AL.

Examiner

Cybille Delacroix-Muirheid

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002 and 19 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-28 is/are allowed.
- 6) ☒ Claim(s) 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

1. Claims 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Yen et al., 5,422,116 or Cole 5,147,698 or Hashimoto et al., 5,474,989.
2. Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al., 5,474,989.
3. Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Yen et al., 5,422,116 or Cole 5,147,698.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

The following is responsive to Applicant's amendment and declaration received Sep. 23, 2002 and Nov. 19, 2002.

The previous objection to the oath/declaration, set forth in paragraph 1 of the office action mailed March 22, 2002, is withdrawn in view of the supplemental oath/declaration received Nov. 19, 2002.

Applicant's arguments traversing the previous grounds of rejection under 35 USC 102(b), set forth in paragraphs 4-7 of the office action mailed March 22, 2002 have been considered but are not found to be persuasive.

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Said rejections are maintained essentially for the reasons given previously in the office action mailed March 22, 2002 with the following additional comment:

It is Applicant's position with respect to claims 29-32 that the modified chitosan polymers are produced by particular methods of the invention. Thus the term "modified" has a specific meaning and refers the Examiner to language in the specification, page 15, lines 5-7. It is Applicant's position that none of the references disclose such a modified chitosan polymer. Neither Yen, Cole or Hashimoto disclose the modified chitosan polymers of the claimed invention. Said arguments also apply to the rejection of claims 33-34. Again, Applicant argues that none of the references disclose the claimed modified chitosan polymers.

Said arguments have been considered but, respectfully, are not found to be persuasive.

Applicant's arguments that the modified polymers of claims 29-32 are produced by a particular method of the invention, therefore giving the term "modified" a specific meaning have been noted. However, The Examiner respectfully maintains that claims 29-32 are product-by-process claims and are considered to be product claims. A product-by-process claim is a product claim, not a process claim. Please see In re Lyons, 150 USPQ 741 (CCPA 1966). Therefore, process limitations cannot impart patentability to a product which is not patentably distinguished over the prior art. Please see In re Thorpe et al., 227 USPQ 464 (CAFC 1985). In this case, the particular method of the invention cannot impart patentability to the claimed product which is not patentably distinguished from the prior art. Yen, Cole or Hashimoto disclose chitosan

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polymers which have been "modified" in various ways. Said references also disclose the claimed viscosity.

Concerning claims 33 and 34, the Examiner maintains that Hashimoto, Yen or Cole disclose chitosan polymers which have been "modified" from their natural forms. Therefore, the claims continue to be anticipated by these references.

It is for these reasons that the claims stand rejected.

Conclusion

Claims 1-28 are allowable.

Claims 29-34 stand rejected.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

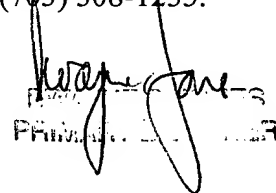
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

CDM



Dec. 11, 2002



Handwritten signature and stamp, possibly reading "PRIVACY" and "CONFIDENTIAL".